

**THIS OPINION IS NOT A
PRECEDENT OF THE TTAB**

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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re The Children's Place Services Company, LLC

Serial No. 77216094

J. Allison Strickland and Tamar Niv Bessinger of Fross
Zelnick Lehrman & Zissu, P.C. for The Children's Place
Services Company, LLC

Drew Leaser, Trademark Examining Attorney, Law Office 112
(Angela Bishop Wilson, Managing Attorney)

Before Seeherman, Walsh and Ritchie, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

On June 26, 2007, The Children's Place Services
Company, LLC applied to register THE CHILDREN'S PLACE, in
the stylized form shown below, which is described as "THE
CHILDREN'S PLACE in white on a blue background,"



for the following goods and services:

children's backpacks and pocketbooks
(Class 18);

wash cloths; bath towels; bed blankets
(Class 24);

children's clothing, namely pants,
shorts, shirts, sweaters, sweat shirts,
vests, jackets, swimwear, headwear,
socks, underwear, sleepwear, scarves,
coats, skirts, dresses, tights,
leotards, gloves, footwear, clothing
belts and Halloween costumes (Class
25);

toys, namely, bath toys; stuffed toys
and clothing for stuffed toys (Class
28);

retail store services featuring
children's clothing and accessories;
electronic catalog services featuring
children's clothing and accessories;
mail order catalog services featuring
children's clothing and accessories;
issuing gift certificates which may
then be redeemed for goods or services
(Class 35).

The application is based on Section 1(a) of the Trademark Act, asserting use anywhere and use in commerce as early as 1999. Applicant claimed ownership of registrations Nos.1020742, 1137068 and 2165998.

In the first Office action, the examining attorney required a disclaimer of CHILDREN'S on the basis that the term is merely descriptive of a feature, characteristic or purpose of applicant's goods. In response, applicant submitted a claim of acquired distinctiveness as to the

word CHILDREN'S based on five years of use. In the second Office action the examining attorney stated that, because the word CHILDREN'S is highly descriptive of applicant's goods and/or services, the allegation of five years' use was insufficient to show acquired distinctiveness.

Applicant responded to this action by submitting evidence of acquired distinctiveness in the form of an excerpt from its 2008 10K report filed with the SEC showing net sales of the company for the fiscal year ending 2008 amounting to \$2.2 billion. Applicant also submitted copies of three of its registrations for variations of its THE CHILDREN'S

PLACE marks:

the children's place

with CHILDREN'S
disclaimed, for "retail
store services
specializing in
children's clothing and
toys";¹

THE CHILDREN'S PLACE (typed format, with
CHILDREN'S disclaimed), for "retail store
services specializing in children's clothing,
maternity clothing, children's furniture, toys
and accessories";² and

¹ Registration No. 1137068.

² Registration No. 1020742.



the children's place

with CHILDREN'S disclaimed, for "retail store services specializing in children's clothing, maternity clothing, children's furniture, toys and accessories."³

Applicant's counsel also stated in the response that "since 1970, Applicant has used it's the CHILDREN'S PLACE trademark in connection with all of the categories of goods and services in the present application," although applicant did not submit a declaration to this effect. The 1970 date appears to reference the use of various THE CHILDREN'S PLACE marks, since the response also states that "Applicant has been using the current stylization of THE CHILDREN'S PLACE in a stacked blue logo, in connection with all of the goods and services in the application," since 1999. In addition, applicant submitted a copy of an unreported decision by the U.S. District Court for the Southern District of New York, TCPIP Holding Co. v. Haar Communications Inc., 99 Civ. 1825 (July 19, 2004). Applicant has submitted that decision for certain findings, including the finding that it (as plaintiff) was entitled to judgment on its dilution claim because it demonstrated that "its mark is famous through uncontroverted affidavits

³ Registration No. 1120741.

attesting to Plaintiff's advertising and sales." The Court stated that "Plaintiff has used its mark in connection with its retail stores services for over thirty years and in connection with children's clothing and accessories since 1991." In connection with plaintiff's cybersquatting claim the Court found that plaintiff's trademark is famous because plaintiff "introduced uncontroverted evidence showing that it has recorded sales of approximately \$2 billion and has spent over \$33 million to advertise and promote its products from 1992 to 2001," and that this evidence "indicates that Plaintiff has achieved a degree of fame in the retail marketplace comparable to stores such as The Gap or Kids "R" Us."

The examining attorney issued a final Office action maintaining the requirement for a disclaimer of CHILDREN'S, and asserting that CHILRDEN'S is generic in the context of applicant's goods and services. As a result, applicant's claim of acquired distinctiveness as to this word was found unacceptable. The examining attorney also pointed out that in the federal court decision the Court treated applicant's various THE CHILDREN'S PLACE marks as distinctive because federal registrations had issued for such marks without resort to Section 2(f). However, the examining attorney

noted that in each of these registrations cited by the Court the word CHILDREN'S had been disclaimed.

Applicant then filed a request for reconsideration, submitting much of the same evidence it had previously submitted, but also submitting the declaration of its Senior Counsel, Ellen Cho. The declaration states, inter alia, that, since 1970, "applicant has used its THE CHILDREN'S PLACE trademark in connection with all of the categories of goods and services in the present application"; that it has been using the applied-for mark in connection with all of the goods and services in the application since 1999," although its use of the word mark THE CHILDREN'S PLACE for "children's clothing, toys, and accessories goes back many decades; that Ms. Cho believes that THE CHILDREN'S PLACE mark has acquired distinctiveness to consumers of the goods covered by the application; and that applicant's net sales under THE CHILDREN'S PLACE mark for the fiscal year ending February 2008 exceeded \$2 billion.

At this point in examination the application was assigned to the present examining attorney, who denied the request for reconsideration. He asserted that CHILDREN'S is generic in connection with applicant's goods and services and therefore incapable of registration even with

a showing of acquired distinctiveness, and characterized the word CHILDREN'S as a generic adjective. Because of this position, the examining attorney did not address the question of the sufficiency of applicant's evidence in case CHILDREN'S were not found to be generic, but it is clear that he has not conceded this point. Specifically, in his appeal brief the examining attorney states that a disclaimer of CHILDREN'S is required because this word is generic in connection with applicant's goods and services, and in the alternative, it is so highly descriptive that applicant's evidence is insufficient to demonstrate that the word CHILDREN'S has acquired distinctiveness, such that a disclaimer is required.

We first discuss some procedural points. With its reply brief applicant submitted several third-party registrations. Apparently recognizing that the record must be complete prior to the filing of an appeal, see Trademark Rule 2.142(d), applicant states that the registrations are provided to illustrate applicant's reply to the examining attorney's brief, and "are not submitted as formal evidence of applicant's position." p. 6. Despite applicant's characterization of this material, the fact is that the registrations submitted with the reply brief are untimely,

and neither they nor the arguments based on these registrations have been considered.⁴

Applicant points out that, in the final Office action, the examining attorney raised for the first time the objection that CHILDREN'S is generic for the goods and services, and in denying the request for reconsideration, asserted for the first time that CHILDREN'S is a generic adjective. We do not regard the assertion that CHILDREN'S is generic or a generic adjective as a new ground of refusal, such that the final Office action was premature. That is, the examining attorney had asserted in both the second and in the final Office action that the evidence submitted by applicant was insufficient to demonstrate that the word CHILDREN'S in its mark had acquired distinctiveness; the claim that the term is generic or a generic adjective merely provides additional information as to why the evidence of acquired distinctiveness was insufficient. In any event, applicant did have an opportunity, in its request for reconsideration, to respond to the assertion that CHILDREN'S is generic, and did so

⁴ Even if we had considered the five third-party registrations, they would not affect our decision herein. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (it is well established that even if some prior registrations have some characteristics similar to the applicant's, the USPTO's allowance of such prior registrations does not bind the Board).

with both evidence and argument. Accordingly, we see no need at this point in the appeal, after briefing has been completed, to remand the application to the examining attorney to issue a new Office action.

We also address the effect of the decision of the District Court in TCPIP Holding Co. v. Haar Communications Inc., 99 Civ. 1825 (July 19, 2004). Applicant would have us find that the mark THE CHILDREN'S PLACE is famous and distinctive because the District Court did so. However, fame and distinctiveness are legal conclusions based on the evidence adduced in a particular proceeding, and in the context of the claims in that proceeding. The evidence that was submitted to the District Court has not been made of record herein, and the claims are different. The Court's finding that applicant's mark is distinctive (made in connection with the cybersquatting claim) was based on the fact that four registrations issued by the U.S. Patent and Trademark Office for three of applicant's THE CHILDREN'S PLACE marks without a showing of acquired distinctiveness. The registrations are not identified in the opinion, although it appears that the registrations are those listed earlier in this opinion and, as noted above, in those registrations the word CHILDREN'S has been disclaimed. We cannot view the Court's finding that these

registrations, with a disclaimer of CHILDREN'S, show that THE CHILDREN'S PLACE is registrable without such a disclaimer.

Section 6(a) of the Trademark Act, 15 U.S.C. § 1056, provides that the Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. Section 2(e)(1) prohibits the registration of a mark which, when used in connection with the goods of the applicant, is merely descriptive of them. 15 U.S.C. § 1052(e)(1). Section 2(e)(1) is also the statutory basis for refusing registration of generic terms, as a generic term is considered the ultimate in descriptiveness.

Applicant does not dispute that the word CHILDREN'S is merely descriptive of the goods and services identified in the application. However, applicant contends that the word need not be disclaimed because CHILDREN'S has acquired distinctiveness, although at the same time applicant's evidence regarding acquired distinctiveness goes to the mark as a whole. Applicant's attempts to shoehorn its claim of acquired distinctiveness for the word CHILDREN'S to fit under the general principles regarding claims of acquired distinctiveness for marks as a whole have resulted in inconsistent and ultimately untenable arguments. It has also resulted in some inconsistent arguments by the

examining attorney in his attempts to respond to applicant's position.⁵

There has been a great deal of discussion about whether CHILDREN'S is a generic term for the goods and services, with the examining attorney arguing that CHILDREN'S is a generic adjective and submitting evidence to show such genericness, and applicant arguing that CHILDREN'S is a possessive noun and that the case law does not support such a figure of grammar being characterized as generic.

However one wishes to characterize the part of speech, the evidence submitted by the examining attorney, as well as applicant's own identification of goods, shows that CHILDREN'S is a generic term for such goods and services as children's clothing and retail store services featuring children's clothing. We are not persuaded by applicant's argument that the class name for a "children's store" is "store," rather than "children's store," and that the class

⁵ For example, the examining attorney has misinterpreted applicant's argument in its appeal brief that its mark is unitary. Applicant made this statement in connection with its claim that its Section 2(f) evidence as to the mark as a whole is applicable to the word CHILDREN'S in the mark. However, because "unitary" is a term used in determining whether a disclaimer is necessary, the examining attorney viewed applicant's argument as a reference to this concept. (Because this argument was not raised by applicant, we need not discuss it further, but for the record, the exception to disclaimers made for unitary marks is not applicable to the mark herein.)

name for "children's shirts" is "shirts." Brief, p. 5. Using this reasoning, a party could register CHILDREN'S for children's stores or children's shirts, and thereby register a generic term. In *In re Central Sprinkler Co.*, 49 USPQ2d 1194 (TTAB 1998), the applicant attempted a similar argument to overcome a refusal that ATTIC is a generic term for "automatic sprinklers for fire protection, contending that the category for the goods at issue was "fire extinguishing equipment" or "sprinklers for extinguishing fire." The Board found ATTIC to be generic, and stated, at 49 USPQ2d 1197:

The broad general category of goods involved here is sprinklers for fire protection. However, a product may be in more than one category, and here applicant's goods also fall within the narrower category of sprinklers for fire protection of attics. We find that the term "attic" would be understood by the relevant public as referring to that category of goods.

However, we need not enter into an extended discussion of whether CHILDREN'S is a generic term for applicant's identified goods and services, because it is clear that CHILDREN'S is, at the very least, merely descriptive of them.

As noted, applicant has acknowledged that the word CHILDREN'S in its mark is descriptive of both the items

sold in applicant's stores and of the consumers of applicant's goods: "...in the mark THE CHILDREN'S PLACE, the term CHILDREN'S is descriptive, rather than generic, because it identifies the intended user of the goods and services." Brief, p. 5. Therefore, it is an unregistrable component of the mark and is properly subject to disclaimer. Applicant has attempted to avoid such disclaimer, however, by arguing that the term has acquired distinctiveness and therefore is no longer merely descriptive of the goods and services. The problem, however, is that applicant has not submitted evidence that CHILDREN'S per se has acquired distinctiveness. On the contrary, it is applicant's position that it is the phrase THE CHILDREN'S PLACE as a whole that has acquired distinctiveness, and all the evidence it has submitted is in connection with the mark as a whole. But applicant is not seeking registration for the mark as a whole under Section 2(f); its Section 2(f) claim is limited to the word CHILDREN'S. Therefore, applicant's arguments that, when registration is sought pursuant to Section 2(f), a disclaimer of a descriptive element of the mark is not required, are not applicable to the present situation.

Applicant argues that it has limited its claim in this manner because CHILDREN'S is the only part of its mark for

which a disclaimer was required. Applicant also asserts that it "could have claimed Section 2(f) for the mark as a whole, or for any element of the mark, and the 2(f) claim would have equivalent." Reply brief, p. 3. This is incorrect. Applicant relies on language in TMEP § 1212.02(d) and on *In re Del E. Webb Corp.*, 16 USPQ2d 1232 (TTAB 1990). However, the language quoted by applicant in its brief, "if the applicant wishes, a claim of acquired distinctiveness under § 2(f) may be made as to the entire mark or phrase that contains both inherently distinctive matter and matter that is not inherently distinctive," refers to the situation in the preceding sentence: "If the applicant specifically requests registration of the entire mark under §2(f), but the examining attorney believes that part of the mark is inherently distinctive, the examining attorney should give the applicant the option of limiting the §2(f) claim to the matter that is not inherently distinctive." Thus, the TMEP and the Del E. Webb case refer to the opposite of the situation here, namely, that if a mark contains inherently distinctive as well as descriptive elements, the applicant may make a claim of acquired distinctiveness under Section 2(f) as to the entire mark. That is, the presence of inherently distinctive matter in a mark does not prevent an applicant

from asserting that the mark as a whole has acquired distinctiveness. This option was available to the applicant, and it chose not to pursue it.⁶

We do not accept applicant's argument that the quoted provision of the TMEP "makes clear that when a descriptive term is included in a mark, the 2(f) claim need not encompass the mark in its entirety, but only the descriptive portion(s) of the mark." On the contrary, the TMEP makes clear that the quoted language does not apply to applicant's situation. Between the two sentences in TMEP § 1212.02(d) quoted above is the following sentence: "See TMEP § 1212.02(f)(i) regarding claims of §2(f) distinctiveness as to a portion of a mark." Section 1212.02(f)(i), which discusses the situation of in which a Section 2(f) claim is made to a portion of a mark, provides that "Generally, the element that is the subject of the §2(f) claim must present a distinct commercial impression apart from the other elements of the mark. That is, it must be a separable element." As the examining attorney points out, applicant does not claim that, as used in its mark THE CHILDREN'S PLACE, CHILDREN'S presents a distinct

⁶ Of course, matter that is generic must still be disclaimed from a mark for which registration under Section 2(f) is sought, but because applicant did not claim acquired distinctiveness as to the mark as a whole, that issue is not before us.

commercial impression; rather, because it modifies PLACE, it does not.

Applicant argues that there is no requirement "that any particular descriptive element of a mark—when considered separately from the mark as a whole—must have acquired distinctiveness; rather, when all of the elements of the mark are considered together, in the manner that the mark is actually used, if the mark has acquired distinctiveness, it qualifies for registration under Section 2(f)." Reply brief, p. 4. As the second part of that sentence indicates, that is the case when registration under Section 2(f) is sought for the entire mark. However, that is not what applicant is attempting to do. Applicant is seeking to assert acquired distinctiveness only for the word CHILDREN'S in its mark, and to find acquired distinctiveness for this word alone, CHILDREN'S would have to make a distinct commercial impression. It does not.

Accordingly, we find that CHILDREN'S is, at the very least, a merely descriptive term as used in applicant's mark, and the requirement for a disclaimer of this unregistrable matter is appropriate.

Decision: The requirement for a disclaimer of CHILDREN'S is affirmed, and the refusal of registration without such disclaimer is affirmed as well. However, if

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applicant submits the required disclaimer within thirty days of the mailing date of this decision, the decision will be set aside and the application will be approved for publication.